

ATTORNEY DOCKET NO. 10628ROUS01U (NORT10-00169)

U.S. SERIAL NO. 09/472,910

PATENT

REMARKS

Claims 2-35 are pending in the application.

Claims 2-35 have been rejected.

Reconsideration of the claims is respectfully requested.

II. REJECTION UNDER 35 U.S.C. § 102

Claims 2-4, 7, 9, 16, 18-20 and 24 were rejected under 35 U.S.C. § 102(e)¹ as being anticipated by U.S. Patent No. 6,046,762 to *Sonesh et al.* The rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

As previously noted, independent claim 2 recites sending at least one data information message via the packet-based network if the attendant availability parameter is not met, where a format for that data information message is determined based upon the capabilities of the call-

¹ Like the prior Office Action mailed May 22, 2002, the final Office Action states that the rejection is based on 35 U.S.C. § 102(b). Paper No. 5, page 2. However, since the issue date of *Sonesh et al.* (April 4, 2000) is later than the filing date of the subject application (December 27, 1999) and therefore does not satisfy the requirement of being "patented . . . more than one year prior to the date of the application for patent" under 35 U.S.C. § 102(b), Applicant assumes that a rejection under 35 U.S.C. § 102(e)(2) was intended.

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initiating remote telephone station as ascertained by a query from the call reception logic to the call-initiating remote telephone station.

As described in Applicants specification, ACD controller 42 queries the capabilities (e.g., display screen size, number and configuration of buttons and softkeys, whether remote control of the display and softkeys is permitted) of a remote telephone station 48. Specification, page 21, lines 9-23. If the remote telephone station has sufficient capabilities, including preferably HTTP support and a browser application, ACD controller 42 installs (if not already installed) XControl and RemoteUIApp software and sends control signals via those protocols, including the at least one data information message sent if the attendant availability parameter is not met. Specification, page 21, line 24 through page 22, line 14 and page 23, lines 3-19. The XControl and RemoteUIApp protocols control the format (including content) of display screen messages, softkey option label messages and softkey pressed control messages (including the at least one data information message sent if the attendant availability parameter is not met) exchanged between the ACD controller 42 and remote telephone station 48. Specification, page 18, line 25 through page 19, line 17. For example, if the remote telephone station 48 runs an Internet Protocol (IP) soft client program (e.g., supports HTTP and has a browser installed), the messages exchanged between ACD 42 and remote telephone station 48 may comprise mouse clicks and/or keyboard command messages. Specification, page 19, lines 8-17. Thus, the format of the at least one data information (XControl and RemoteUIApp protocol) message sent

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when the attendant availability parameter is not met depends on the capabilities of the remote telephone station.

Such a feature is not described in the cited reference. The cited embodiment of *Sonesh et al* recites that specialized connection software is required to communicate with the call center, and that a determination is made of whether this specialized connection software is present and updated on the initiating computer:

The caller's computer communicates with the call center via connection software, configured as a browser helper module. Step 635 checks whether this connection software exists on the caller's computer and whether it is updated. If not, step 645 involves downloading this software or an update, to the caller's computer. If the software exists at step 635 or after it is downloaded at step 645; step 640 checks for the availability of an agent in the appropriate queue.

Sonesh et al, column 10, lines 50–58. Thus, *Sonesh et al* recites selectively performing an action (downloading or updating the connection software) based on the existence or state of the connection software on the caller's computer, but is silent as to selecting the format of information supplied via the call connection based on the initiating computer's capabilities. To the extent that the existence or state of the connection software on the caller's computer is considered to form part of that computer's "capabilities," *Sonesh et al* recites conforming the initiating computer's capabilities to the format of any information supplied by the call connection, by downloading or updating software to the initiating computer, rather than conforming the format of supplied information to the initiating computer's capabilities.

The final Office Action states:

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Applicant also argues that Sonesh et al. does not suggest that the format of any information supplied via the call connection is conformed to the initiating computer's capabilities. Examiner respectfully disagrees. Sonesh et al does suggest that in column 10, lines 66-67, furthermore, it's obvious-that data information message sent when no attendant is available is determined from the capabilities of the call-initiating telephone, for example, cannot send video or text to a telephone that only has voice capability.

Paper No. 5, pages 12-13. However, the cited portion of *Sonesh et al* does NOT disclose selecting the format of a data information message based on the capabilities of the remote telephone station:

While holding at step 655, the caller can also chat via text, voice, or voice and video with other callers on hold. Step 640 involves periodic checking whether an agent becomes available, and queue information is periodically updated in 650. Once it is determined in 640 that an agent is available, the caller is connected to that agent at 660. The connection can be voice, voice and data, or voice, video and data connection.

Sonesh et al, column 10, line 66 through column 11, line 6. The cited portion of *Sonesh et al* recites different formats for communication connections (voice; voice and data; voice, video and data), NOT different formats for data information messages.

The Office Action's unsupported assertions of obviousness based on the observation that a system "cannot send video or text to a telephone that only has voice capability" and that the format of a "data information message sent when no attendant is available is determined from the capabilities of the call-initiating telephone" deviates from a proper anticipation analysis. Obviousness or suggestion is not a proper basis for an anticipation rejection.

agreed ✓
Claim 9 was rejected as anticipated by *Sonesh et al*. Claim 9 depends from claim 8 which was NOT rejected as anticipated by *Sonesh et al*. Claim 9 cannot be rejected as

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anticipated by *Sonesh et al* unless claim 8 is also anticipated by *Sonesh et al*. Accordingly, the Office Action fails to establish a *prima facie* rejection for claim 9 and therefore, the Applicant respectfully requests withdrawal of the final office action and issuance of a new office action with a proper basis of rejection for claim 9.

Independent claim 16 recites that if the attendant availability parameter is not met, at least one data information message containing audio/softkey option labels is sent to the particular remote telephone station (initiating the call) via the packet-based network. In an exemplary embodiment, a waiting screen message including softkey option labels (identifying keys which may be pressed to activate, for example, a music choice operation, an alert request operation, etc.) are sent along with waiting parameters (e.g., the caller's position within a priority queue) to the call-initiating remote telephone if no attendant is currently available to answer the call. Specification, Figure 6 (step 138), page 23, lines 16-30. Such a feature is not described in the cited reference. *Sonesh et al* does not recite that audio or softkey option labels are sent to the initiating telephone within a data message if an attendant is not available.

The Office Action states:

Applicant argues that *Sonesh* does not disclose that audio or softkey option labels are sent to the initiating telephone within a data message if an attendant is not available. Obviously softkey is well known in the art and defined in *Newton's Telecom Dictionary* by Harry Newton 8th Expanded and Updated Edition page 950.

Paper No. 5, page 12. As an initial matter, the portions of *Newton's Telecom Dictionary* attached to the final Office Action do not establish that reference as prior art to the subject application.

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In addition, *Newton's Telecom Dictionary* is not of record in the subject application, and is not identified in the grounds for rejection of the subject claim.

Still further, multiple references may be cited in anticipation rejection only where the secondary reference is employed (1) to prove that the primary reference contains an enabling disclosure, (2) to explain the meaning of a term used in the primary reference, or (3) to show that a characteristic not disclosed in the primary reference is inherent. MPEP § 2131.01. Merely establishing knowledge of softkey option labels by those skilled in the relevant art is not a permissible use of multiple references in an anticipation rejection. Finally, the test of anticipation is not satisfied by merely establishing knowledge of softkey option labels by those skilled in the relevant art; rather, disclosure of every element of a claimed invention in a single reference, arranged identically as they are in the claims, is required to establish anticipation. *Sonesh et al* does not describe including audio or softkey option labels in a data information message sent to a call-initiating remote telephone station when the attendant availability parameter is not met.

For the same reasons as set forth above, dependent claims 18-20 are not anticipated by *Sonesh et al*.

As previously noted, independent claim 24 recites monitoring for receipt of an attendant request message to enable connection to an attendant while browsing data information. In an exemplary embodiment, the remote telephone may simply employ a browser to access data information made available in response to a call without being queued for an attendant, then

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initiate an attendant request while viewing the data information. Specification, page 31, line 25 through page 32, line 7. Such a feature is not described in the cited reference. The cited portion of *Sonesh et al* recites allowing a user to view a web site while holding for an attendant, but only after initiating a call requesting connection to an attendant. *Sonesh et al* does not disclose allowing the caller to browse data information independent of a request for connection to an attendant after placing a call to a call center, then request connection to an attendant during the browsing session.

The Office Action states:

Furthermore, at to Applicant's arguments regarding *Sonesh et al*. does not suggest allow the caller to browse data information independent of a request for connection to an attendant, then request connection to an attendant during the browsing session. Examiner respectfully disagrees. *Sonesh et al*. does suggest that in column 10, lines 34-36.

Paper No. 5, page 13. However, the cited portion of *Sonesh et al* merely recites allowing a user to initiate a call during browsing:

FIG. 6 illustrates a typical method of access to a call center by means of the Internet. At step 601, a caller connects to the Internet by means of WWW browser software and accesses a call center web page. The caller types in identification, service request information and presses or clicks requesting connection to a call center Agent as illustrated in step 605.

Sonesh et al, column 10, lines 34-39. *Sonesh et al* does NOT describe receiving call initiation signals from a remote telephone station, initiating a browsing session (regardless of whether an attendant is available) with the remote telephone station in response to the call initiation signals, then monitoring for an attendant request message from the remote telephone station and

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processing such a request, if received, based upon attendant availability, as recited in the subject claim.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102 rejection of Claims 2-4, 7, 9, 16, 18-20 and 24.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 5-6, 30-31 and 34-35 were rejected under 35 U.S.C. § 103 as being unpatentable over *Sonesh et al* in view of U.S. Patent No. 5,991,394 to *Dezanno*. Claims 8, 10-12, 14-15, 17 and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over *Sonesh et al* in view of U.S. Patent No. 5,884,032 to *Bateman et al*. Claim 28 was rejected under 35 U.S.C. § 103 as being unpatentable over *Sonesh et al* in view of U.S. Patent No. 6,301,354 to *Walker et al*. Claims 13, 21-22, 25-27, 29 and 32-33 were rejected under 35 U.S.C. § 103 as being unpatentable over *Sonesh et al*. The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444

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(Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Independent claim 8 (rejected over *Sonesh et al* in view of *Bateman et al*) and claims 30 and 34-35 (rejected over *Sonesh et al* in view of *Dezanno*) each recite that the call reception logic monitors for receipt of an alert request activation which causes an alert message to be sent to the call-initiating remote telephone when an attendant becomes available. Such a feature is not described by the cited references. *Sonesh et al* does not describe either requesting an alert

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or sending an alert message to a caller awaiting attendant availability. *Bateman et al*, which relates to an on-line help system, recites automatic call-back from an available agent as the sole process by which "live help" from an available agent may be obtained, rather than activation of such a call-back mechanism only upon request by a caller waiting for an available agent after placing a call. *Bateman et al*, column 6, lines 1-58. *Bateman et al* is silent as to any alert request activation message allowing a user to control whether an alert message is sent when an agent becomes available. The cited portion of *Dezonno* relates to a timer for dialing calls at a specific, desired time, coupled with detection of whether a human (rather than an answering machine or the like) answers the call, and connection of the call to an agent when a human answers the call. *Dezonno*, column 4, line 51 through column 5, line 31. *Dezonno* thus recites completing a call connection (rather than aborting the call and redialing later) when an initiated call is answered by a human. However, *Dezonno* is silent as to receiving an alert request activation message allowing a caller to selectively request an alert while holding for an available attendant after placing a call, with the alert being sent when an attendant becomes available to handle the call which is holding.

The final Office Action states:

Applicant argues that the following feature is not shown or suggested by the cited references: caller to selectively request an alert message to be sent to the call initiating telephone while holding for an available attendant. Examiner respectfully disagrees. Sonesh et al. suggest that in column 11, lines 3-4 and also Bateman et al in column 6, lines 52-58.

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Paper No. 5, page 13. However, the cited portion of *Sonesh et al* merely recites automatically connecting a caller to an agent once the agent becomes available:

Once it is determined in 640 that an agent is available, the caller is connected to that agent at 660.

Sonesh et al, column 11, lines 3-4. *Sonesh et al* is silent as to sending an alert message when the agent becomes available, or allowing a user to selectively request an alert message when an agent becomes available. *Bateman et al*, as noted above, recites a call-back as the only means of establishing a voice call with an agent, and is silent as to sending an alert message (as opposed to merely placing the return call) and allowing a user to selectively request that an alert message be sent once an agent becomes available.

Accordingly, independent Claims 8, 30, 34 and 35 are nonobvious over *Sonesh et al* and *Bateman et al* or *Dezanno*. For the same reasons, dependent claims 10-12, 14, 15 and 31 are nonobvious.

Dependent claims 13, 32 and 33 were rejected only over *Sonesh et al*, NOT over *Sonesh et al* in view of *Bateman et al*. Therefore, for the same reasons above with respect to independent claims 8 and 30, the claims 13, 32 and 33 are nonobvious.

Similar to independent claim 16, independent claims 25, 27 and 29 each recite that if the attendant availability parameter is not met, at least one data information message containing audio/softkey option labels is sent to the particular remote telephone station (initiating the call) via the packet-based network. As noted above, such a feature is not described, taught or suggested in *Sonesh et al*. For the same reasons, dependent claims 26 and 28 are nonobvious.

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For the same reasons above with respect to the anticipation rejection of independent claims 2 and 16 (and arguments with respect to the other 103 rejections), dependent claims 5, 6, 17, 21, 22 and 23 are nonobvious.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 5-6, 8, 10-15, 17, 21-23, 25-29 and 30-35.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

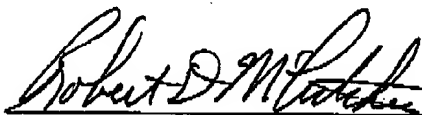
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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1/13/2003



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